REMARKS

Claims 1-21 stand rejected under 35 USC §103(a) as being unpatentable over US patent 5,136,647 to Haber et al. ("Haber") in view of US patent 6,006,227 to Freeman et al. ("Freeman"). The rejection is respectfully traversed because *prima facie* obviousness is not established. The rejection fails to show that all the limitations are suggested by the combination, fails to provide evidence in support of a motivation to combine the references, and fails to show that the teachings of the references could be combined with a reasonable likelihood of success.

Independent claims 1 and 17 include limitations that relate to obtaining respective time-stamp certificates for a plurality of documents, the documents and the certificates having associated identifiers; building a database of document identifiers and associated certificate identifiers; and storing the documents and the certificates. The rejection appears to allege that Haber suggests time-stamping digital documents and that Freeman suggests storing documents in one or more chronologically ordered streams. However, the limitations that relate to the database of document identifiers and associated certificate identifiers appear to be ignored in the rejection. Or, if the rejection is interpreting these limitations to be suggested by Freeman's chronologically ordered streams of documents, it is not understood what the perceived correlation is between the specific claim limitations and specific elements of Freeman. Furthermore, these limitations do not appear to be suggested by other portions of the cited references. For at least these reasons, the rejection fails to provide evidence that the limitations are suggested by the combination.

The alleged motivation for combining the references is that "it would facilitate organized storage of certified documents, thereby enabling an administrator to verify an audit trail." This alleged motivate is not understood, and no evidence is

provided to support the alleged motivation. The rationale to "verify an audit trail" is vague and ambiguous, and its relation to the specific claim limitations is neither explained in the rejection nor decipherable on its face. Furthermore, the rejection fails to provide any evidence from either Haber or Freeman that organizing the certified documents according to the claim limitations would be beneficial for verifying audit trails.

Addressing the "rigorous … requirement for a showing of the teaching or motivation to combine prior art references," the Court of Appeals for the Federal Circuit recently stated in *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999):

> We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, (citations omitted), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. *See, e.g., C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." (citation omitted)

The alleged motivation is merely a broad conclusory statement of a vague function, and no evidence is provided to suggest the combination. Furthermore, it is not apparent that modifying Haber with the teachings of Freeman would have a reasonable likelihood of success. Therefore, the alleged motivation is insufficient to support *prima facie* obviousness.

The asserted combination is further deficient because Freeman's teachings appear to teach away from limitations of the present invention that relate to manipulating document identifiers. Specifically, Freeman teaches:

> "Naming" a file when created and choosing a location in which to place the file is unneeded overhead: when a person graphs a piece of paper and starts writing, no one demands that a name be bestowed on the sheet or that a storage location be found. Online, many filenames are not only pointless but useless for retrieval purposes. Storage locations are effective only as long as the user remembers them. (col. 1, ll. 52-59)

Freeman maintains a "stream", which "is a time-ordered sequence of documents that functions as a diary of a person or an entity's electronic life." (col. 4, ll. 6-11). Thus, Freeman provides a system that apparently seeks to obviate the need for document identifiers. The present invention uses the document identifiers and associated certificates to manage the documents. Therefore, Freeman appears to teach away from the present invention.

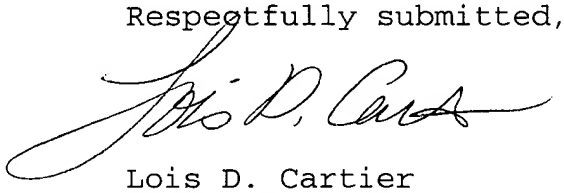
Claim 7 is depends from claim 1 and is allowable for at least the reasons set forth above. The remaining claims are not specifically addressed in the Office Action and are also believed to be allowable for at least the reasons set forth above.

The Office Action fails to provide evidence of a suggestion of all the limitations of the pending claims, fails to provide a proper motivation for modifying the teachings of Haber with Freeman, and fails to provide evidence of a reasonable likelihood of success in modifying the teachings of Haber with Freeman. Therefore, a *prima facie* case of obviousness has not been established, and the rejection should be withdrawn.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

Respectfully submitted,



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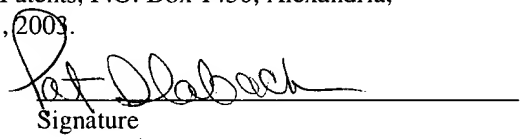
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